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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,220	11/15/2001	Melvin Edwin Kamen	10554-089-999	4219

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EXAMINER
SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
1714	4

DATE MAILED: 05/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/002,220	KAMEN ET AL.	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-28 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 27 and 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 21 of U.S. Patent No. 6,093,455 (Kamen et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Claims 1 and 21 of Kamen et al. are identical to present claims 27 and 28 with one exception. Claims 1 and 21 disclose subjecting the decorated vitreous article to a temperature of about 90-200 ^{0}C to bond the ink to the vitreous article while the present claims require subjecting the decorated vitreous article to a temperature that is higher than about 90 ^{0}C to bond the ink to the vitreous article.

Thus, it is clear that the temperature of the copending claims overlaps the temperature of the present claims. Applicants attention is drawn to MPEP 2144.05 which discloses that in "the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art', a *prima facie* case of obviousness exists", *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Given that the temperature disclosed by Kamen et al. clearly overlap those presently claimed and in light of the above cited portion of the MPEP, it therefore would have been obvious to one of ordinary skill in the art to arrive at the present invention from the copending one.

3. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,093,455 (Kamen et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Claims 1-26 of Kamen et al. disclose a method for decorating a vitreous article and method for stripping decorative indicia from a glass substrate decorated with a radiation cured

ink composition comprising free acid groups which are identical to the methods disclosed in the present claims with the exceptions that:

(i) Kamen et al. disclose subjecting the decorated vitreous article to a temperature of about 90-200 ^{0}C to bond the ink to the vitreous article while the present claims require subjecting the decorated vitreous article to a temperature that is higher than about 90 ^{0}C to bond the ink to the vitreous article and

(ii) Claims 1-26 of Kamen et al. disclose that the decorated vitreous article is subjected to the elevated temperatures for 0.5-30 minutes while the present claims are silent with respect to time.

With respect to (i), applicants attention is drawn to MPEP 2144.05 which discloses that in "the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art', a *prima facie* case of obviousness exists", *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Given that the temperature disclosed by Kamen et al. clearly overlap those presently claimed and in light of the above cited portion of the MPEP, it therefore would have been obvious to one of ordinary skill in the art to arrive at the present invention from the copending one.

With respect to (ii), it is noted that in light of the open language of the present claims, i.e. "comprising", the methods of the present claims are clearly open to the inclusion of further steps or limitations including requirements regarding time.

Further, it is noted that the present claims recite that the decorated vitreous article is subjected to the elevated temperatures until the ink is sufficiently adhered to the vitreous article.

Applicants attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438,164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to page 18, lines 3-7 of the present specification where it is disclosed that in order to completely cure and fuse the ink to the substrate, the decorated substrate is subjected to post-cure heating at elevated temperature for 0.5-30 minutes.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to heat the decorated vitreous article for 0.5-30 minutes in order to sufficiently adhere the ink to the vitreous article, and thereby arrive at the claimed invention.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Harada et al. (U.S. 5,096,767) disclose a method of applying to a vitreous article an alkali removable label wherein the label comprises a base paper and an anchor layer which comprises a radiation curable composition composed of radiation curable resin and carboxylic acid wherein the label is strippable from the vitreous article using sodium hydroxide solution. However, in contrast to the present claims, the radiation curable composition is not applied to or adhered to

the vitreous article itself, but rather is adhered to a label which is then in turn adhered to the vitreous article using glue or other adhesive.

Tanaka et al. (U.S. 5,587,405) disclose a method for decorating an article comprising applying a radiation curable ink comprising free acid groups to the article as well as a method of stripping the ink from the article using an aqueous alkali solution. However, Tanaka et al. uses the ink on a plastic article not a vitreous article as presently claimed.

Zhu et al. (U.S. 6,221,933) disclose an ink jet ink that is printed on glass as well as a method of washing the ink from the glass using a sodium hydroxide solution. However, there is no disclosure or suggestion that the ink is radiation curable. Further, given the effective filing date of the reference, it is not applicable as prior art against the present claims under any subsection of 35 USC 102.

Wachtel (U.S. 4,024,096) disclose an ink jet ink composition that is printed on glass as well as a method of washing the ink from the glass using a mild caustic. However, there is no disclosure or suggestion that the ink is radiation curable or comprises free acid groups as presently claimed.

Crotty et al. (U.S. 3,607,764) disclose an aqueous alkali solution used to remove ink from glassware. However, there is no disclosure or suggestion of a method for applying the ink to the glassware by curing the ink by exposing it to radiation or subjecting it to elevated temperature as presently claimed.

Kamen et al. (U.S. 5,391,247) disclose a method for decorating a vitreous article comprising applying to the vitreous article a radiation curable ink comprising free acid groups and curing the ink on the vitreous article by exposing it to radiation in order to adhere the ink to

the article. However, there is no disclosure or suggestion of a subsequent step of subjecting the decorated vitreous article to elevated temperature until the ink is sufficiently adhered to the vitreous article as presently claimed and no disclosure or suggestion to do so given that Kamen et al. disclose that the ink already is adhered well to the vitreous article after curing. Further, there is no disclosure of a method for stripping the ink from the vitreous article as presently claimed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Callie E. Shosho
Examiner
Art Unit 1714

Callie Shosho

Callie Shosho

4/24/02